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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,355	08/01/2005	Ira B. Black	UMD-0103	2346
46046	7590	03/23/2009	EXAMINER	
LICATA & TYRRELL P.C. 66 EAST MAIN STREET MARLTON, NJ 08053			HAYES, ROBERT CLINTON	
		ART UNIT		PAPER NUMBER
		1649		
			NOTIFICATION DATE	DELIVERY MODE
			03/23/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

poreilly@licataandtyrrell.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/533,355	BLACK, IRA B.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Robert C. Hayes, Ph.D.	1649	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 December 2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 3 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 3 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### *Response to Amendment*

1. The amendment filed 12/18/08 has been entered.
2. Applicant's arguments filed 12/18/08 have been fully considered but they are not deemed to be persuasive.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claim 3 stands rejected under 35 U.S.C. 102(b) as being anticipated by Benson et al (IDS Ref # DA), for the reasons made of record in Paper No: 20080909 and as follows.

Applicant argues on pages 4-5 of the response that “[a]though... [Benson and Salton] states in several places that NGF is able to selectively and rapidly upregulate VGF in PC12 cells, citing two other papers by other authors, no where does this reference actually provide data showing that contacting cells with NGF or any other agent to selectively upregulate expression of VGF or any other nucleic acid sequence of instant claim 3 as originally filed....”. In contrast to Applicant's assertions, Benson and Salton is prior art for all it teaches, in which no requirement for “showing” “data” is required for anticipation under 35 U.S.C.102, especially when no actual nucleic acid measuring step of a “level of expression” is required by the current claim language. All that is required is for the reference (i.e., Benson et al) to teach the instantly

claimed invention, which Applicant acknowledges with his statement that “[Benson and Salton] states in several places that NGF is able to selectively and rapidly upregulate VGF in PC12 cells”, in which PC12 cells are “contacted”. The sole recited method step is “contacting a test cell” and somehow showing that “activation” occurred, which Benson does through demonstration of “the increased presence of “selectively and rapidly upregulated” translated product (e.g., pg. 221, bottom of 1<sup>st</sup> column & pg. 226) through increased binding to VGF antibodies when compared to the relative activation of the VGF protein precursor in untreated cells”. Thus, Applicant’s arguments are not persuasive, for the reasons made of record.

In summary, Benson et al teach a method for identifying an agent (i.e., NGF) that increases synaptic growth or plasticity after contacting hippocampal neurons and PC-12 test cells with NGF, by detecting increased activation/expression of VGF protein precursor (e.g., pgs. 119-222, 224, 226 & Fig. 2). Increased activation of the VGF precursor nucleic acid sequence during axonal outgrowth and dendritic maturation is detected by the increased presence of “selectively and rapidly upregulated” translated product (e.g., pg. 221, bottom of 1<sup>st</sup> column & pg. 226) through increased binding to VGF antibodies when compared to the relative activation of the VGF protein precursor in untreated cells; thereby, indicating increased synaptic growth or plasticity, and anticipating claim 3.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (571) 272-0885. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Stucker, can be reached on (571) 272-0911. The fax phone number for this Group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Robert C. Hayes, Ph.D./  
Primary Examiner, Art Unit 1649  
March 16, 2009